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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Michael D. Hooven

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EXAMINER

CHEN, VICTORIA W

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/038,506	Applicant(s) HOOVEN, MICHAEL D.	
	Examiner VICTORIA W. CHEN	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Yamauchi et al. (US 6273887 B1) in view of Ryan (US 6267761 B1).

Regarding claim 1, Yamauchi teaches a device having first [548a] and second [548b] jaws movable between a first open position [Fig. 74A] and a second clamped position [Fig. 74B], each jaw including a clamping surface [Fig. 74B, e.g. for jaw 548a, the clamping surface is interpreted as the bottom surface of 548a, closest to the tissue A, and the surfaces 550 and 551 of element 549a] having a width [width of 548a], a first elongated electrode [549a] extending along the clamping surface of the first jaw and forming a part thereof, the first elongated electrode having a tissue contacting portion [550] which has a length and a width, the clamping surface including non-conductive portions [552, col. 41, ll. 18-23] disposed on each side of the tissue contacting portion of the first electrode, the width of the clamping surface exclusive of the width of the tissue contacting portion of the first electrode being wider than the width of the tissue contacting portion, a second elongated electrode [549b] extending along the clamping surface of the second jaw and forming a part thereof, the second elongated electrode having a tissue contacting portion [550] which has a length and a width, the clamping surface including non-conductive portions [552, col. 41, ll. 18-23] disposed on each side of the tissue contacting

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portion of the second electrode, the width of the clamping surface exclusive of the width of the tissue contacting portion of the second electrode being wider than the width of the tissue contacting portion, the tissue contacting portions of the first and second electrodes being substantially directly opposed to each other along at least a part of their lengths [Fig. 74B] and capable of being adapted to be connected to an RF energy source so that the first and second electrodes are of opposite polarity and operable to create a line of ablation narrower than the width of the clamping surface. Yamauchi fails to teach a first and second handle members, the first and second jaws extending at angles from a first and second elongated extension shaft, respectively, the first jaw and first elongated extension shaft being linearly movable by the handle members relative to the second jaw and second elongated extension shaft between the open and clamped position, and the jaw being parallel to each other in the open and clamped positions and through a range of tissue clamping spacing. Ryan teaches a bipolar electrosurgical instrument [Fig. 3] for treating tissue having a first and second electrode [26, 27] on first and second jaws [22, 21] which extend at angles from first and second elongated extension shafts [17, 19]. the first jaw and first elongated extension shaft being linearly movable by the handle members relative to the second jaw and second elongated extension shaft between the open and clamped position, and the jaws being parallel to each other in the open and clamped positions and through a range of tissue clamping spacing [e.g. Fig. 15]. Ryan teaches the jaws and extension shafts being linearly movable in a parallel motion to each other such that the jaws compress and seal tissue better compared to hinged bipolar forceps [col. 1, ll. 15-23] and prevent shorting [col. 2, ll. 53-55]. Therefore, it would have been obvious to one of ordinary skill in the art to modify the device as taught by Yamauchi with the parallel axial movement of the device as

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taught by Ryan in order to improve the compression and sealing of tissue and to prevent shorting.

Regarding claim 2, Yamauchi teaches a predetermined spacing between the jaws when in the clamped position in order to prevent a short circuit between the electrodes [col. 40, ll. 66-67, col. 41, ll. 1-5], but fails to specify the spacing being between 1-15 mm. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the spacing as taught by Yamauchi since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Regarding claim 3, Yamauchi teaches first [548a] and second [548b] jaws movable between open [Fig. 74A] and closed positions [Fig. 74B], each jaw including an electrode [549a, 549b] and clamping surface [Fig. 74B, e.g. for jaw 548a, the clamping surface is interpreted as the bottom surface of 548a, closest to the tissue A, and the surfaces 550 and 551 of element 549a] in face to face relation with the electrode and clamping surface of the other jaw [Fig. 74B], each clamping surface having a width [width of 548a or 548b] and including non-conductive portions [552, col. 41, ll. 18-23], each elongated electrode extending along the clamping surface and forming a part thereof, each electrode having a tissue contacting portion [550] which has a length and a width, the width of each clamping surface exclusive of the width of the tissue contacting portion of the respective electrode being wider than the width of the tissue contacting portion, the tissue contacting portion of the electrodes being substantially directly opposed to each other along at least a part of their lengths [Fig. 74B], the electrodes capable of being of opposite polarity and capable of being adapted to be connected to a power source for providing

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an electrical current so that when activated the electrodes are operable to create a line of ablation narrower than the width of the clamping surface. However, Yamauchi fails to teach the first and second jaws extending from a first and second elongated extension shaft, respectively, the second extension shaft being slidably movable relative to the first elongated extension shaft and portions of the first and second jaws being substantially parallel to each other through a range of tissue clamping spacing. Ryan teaches a bipolar electrosurgical instrument [Fig. 3] for treating tissue having a first and second electrode [26, 27] on first and second jaws [22, 21] which extend from first and second elongated extension shafts [17, 19], the second extension shaft being slidably movable relative to the first elongated extension shaft [col. 9, ll. 58-63], and the jaws being parallel to each other in the open and clamped positions and through a range of tissue clamping spacing [e.g. Fig. 15]. Ryan teaches the jaws and extension shafts being slidably movable in a parallel motion to each other such that the jaws compress and seal tissue better compared to hinged bipolar forceps [col. 1, ll. 15-23] and prevent shorting [col. 2, ll. 53-55]. Therefore, it would have been obvious to one of ordinary skill in the art to modify the device as taught by Yamauchi with the parallel axial movement of the device as taught by Ryan in order to improve the compression and sealing of tissue and to prevent shorting.

Regarding claim 4, Yamauchi teaches a predetermined spacing between the jaws when in the clamped position in order to prevent a short circuit between the electrodes [col. 40, ll. 66-67, col. 41, ll. 1-5], but fails to specify the spacing being between 1-15 mm. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the spacing as taught by Yamauchi since it has been held that where the general conditions of a

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claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Regarding claim 5, Yamauchi teaches the clamping surfaces of the jaws comprise insulating material [552].

Regarding claims 6 and 7, Yamauchi teaches each electrode is generally centrally located relative to the width of the respective clamping surface [Fig. 74B].

Regarding claims 8 and 9, if the first elongated extension shaft is interpreted as 17, Ryan teaches the second elongated extension shaft [19] is movable relative to the first elongated extension shaft [col. 6, ll. 60-64], which is fixed in place.

Response to Arguments

Applicant's arguments with respect to claims 1-9 have been considered but are moot in view of the new ground(s) of rejection.

New reference Ryan has been added to address the new claim limitations, as seen above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VICTORIA W. CHEN whose telephone number is (571)272-3356. The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Linda C Dvorak/
Supervisory Patent Examiner, Art Unit
3739

/Victoria W Chen/
Examiner, Art Unit 3739